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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/824,877

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Takafumi Soramoto

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EXAMINER

GARG, YOGESH C

ART UNIT

PAPER NUMBER

3625

MAIL DATE

DELIVERY MODE

10/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/824,877

Applicant(s)

SORAMOTO ET AL.

Examiner

Yogesh C. Garg

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37,38 and 40-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37,38,40-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. In the Applicant's amendment received on 9/26/2007 claims 37 and 38 are amended and new claims 40-42 have been added. Claims 1-3, 10-14, 21-22, 36, were previously canceled and claims 4-9, 15-20, 23-35, and 39 were previously withdrawn. Currently claims 37-38 and 40-42 are pending for examination.

Response to Arguments

2. Applicant's arguments with respect to claims 37-38 and 40-42 have been considered but are moot in view of the new ground(s) of rejection in view of the current amendments.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 37-38 and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Bell et al. (US Patent 6,574,606 B1), hereinafter, referred to Bell.

Note: The recitations in the preambles of claims 37-38 have not been given patentable weight because they generally recite the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Regarding claim 37, Bell discloses a system including a portal site server for granting compensations on the Internet having a first URL, and connected to a plurality of other merchant servers [member stores] and users [clients] through the Internet (See Fig.1. The "Merchant Loyalty Server" corresponds to the claimed compensation-granting portal site server on the Internet and can be operated by an insurance company such that member/merchant stores make payments to the merchant loyalty server for providing insurance coverage to the user) comprising:

a compensation-granting database configured to store URL information of the member store in advance and a URL rewriting unit which receives a second URL of a web page upon a user's request, rewrites said second URL to be linked to said first URL if the second URL requested by the user is found in said URL information stored in the compensation-granting database, and transmits said rewritten URL to the user terminal, a history database for storing deal information including information related to the access to the portal site server by the user , and a compensation-granting unit for granting compensation to the user based on the deal information stored in the history

database (See at least Figs. 3 and 6 and col.4, lines 11-51. Bell shows a customer using an interface to access/hyperlink to a URL, that is a merchant loyalty site which offers benefits including insurance coverage to the customers and is connected to various other merchant [member store] servers. The loyalty web site which corresponds to the claimed compensation granting portal site server and the first URL employs a rewriting unit to rewrite the URL of a merchant server linked to it by Hyperlink protocol and transmits this merchant server website that is the URL of the merchant server to the customer when the customer clicks "I Accept" button "32", see Fig.3 and step "65" in Fig.6. Since there are a plurality of merchant/member servers connected to the loyalty site it would be inherent to store the URLs of the plurality of merchant/member servers in a storage space[corresponds to the claimed database configured to store the URL information of the member store] and the information on deals as what insurance coverage to be provided corresponding to a particular merchant[member store] in a storage space [corresponding to the claimed history database]. The loyalty web site in Bell also comprises a compensation-granting unit for granting compensations such as insurance coverage to the customers relating to a deal performed by the user on said web page having said second URL.)

Regarding claim 38, its limitations are closely parallel to the limitations of claim 37 and therefore it is analyzed and rejected on the basis of same rationale as set forth for claim 37 above.

Regarding claim 40, Bell suggest paying additional premium to the insurance company (see at least col.4, lines 39-51. Bell says that the system provides both free

insurance and upgraded insurance coverage. For the upgraded insurance coverage additional premium would be paid by the customer).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 41-42 are rejected under 35 U.S.C. 103(a) as being obvious over Bell in view of Official Notice

Regarding claims 41-42, Bell, as analyzed above, teaches providing insurance benefits. Bell does not explicitly teach that the deal information further includes a validity period of the compensation to be granted and information related to a time of final access to the portal server by the user. However, Examiner takes Official Notice of the well-known fact and practices when issuing insurance coverage to specify the beginning time and the expiry period depending upon the cost. IN view of the Official Notice it would be obvious to one of an ordinary skilled in the art to include information in Bell relating to a validity period of the insurance compensation to be granted and information related to a time of final access to the portal server by the user, that is the starting time of the insurance coverage.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

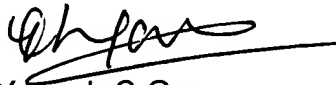
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
10/29/2007